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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,069	09/09/2003	Eugene P. Marsh	M4065.0453/P453-B	9190
24998	7590	10/05/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L STREET NW WASHINGTON, DC 20037-1526			LEWIS, MONICA	
			ART UNIT	PAPER NUMBER
			2822	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/657,069	MARSH ET AL.
	Examiner	Art Unit
	Monica Lewis	2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 July 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 55 and 56 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 55 and 56 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 September 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/03 and 9/03.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed July 16, 2004.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

3. The drawings are objected to because it is not clear what is meant by the ".35" on Figure 5. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soininen et al. (U.S. Patent No. 6,482,740).

In regards to claim 55, Soininen et al. ("Soininen") discloses the following:

a) a first electrode (36) and a second electrode (40) (For Example: See Figure 2);

b) a dielectric (38) provided between said first electrode and said second electrode (For Example: See Figure 2); and

c) at least one of said first and second electrode comprising an ALD deposited rhodium film (For Example: See Column 5 Lines 5-15).

In regards to claim 55, Soininen fails to disclose the following:

a) a continuous ALD deposited rhodium film with reduced carbon content.

Although Soininen fails to specifically disclose the limitations listed above, the same material and process are utilized in Soininen as in Applicant's invention therefore it would have the same characteristics.

Finally, the following limitation makes it a product by process claim: a) "a continuous ALD deposited." The MPEP § 2113, states, "Even though product -by[-] process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)(citations omitted).

A "product by process" claim is directed to the product *per se*, no matter how actually made, *In re Hirao and Sato et al.*, 190 USPQ 15 at 17 (CCPA 1976) (footnote 3). See also *In re Brown and Saffer*, 173 USPQ 685 (CCPA 1972); *In re Luck and Gainer*, 177 USPQ 523 (CCPA 1973); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); and *In re Marosi et al.*, 218 USPQ 289 (CAFC 1983) final product *per se* which must be determined in a "product by, all of" claim, and not the patentability of the process, and that an old or obvious product, whether claimed in "product by process" claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear.

In regards to claim 56, Soininen discloses the following:

- a) a first electrode and a second electrode (For Example: See Figure 2);
- b) a dielectric provided between said first electrode and said second electrode (For Example: See Figure 2); and
- c) at least one of said first and second electrode comprising rhodium film (For Example: See Column 5 Lines 5-15).

In regards to claim 55, Soininen fails to disclose the following:

- a) reduced carbon rhodium film formed by rhodium atomic layer deposition at a temperature of about 100°C to about 200°C.

Although Soininen fails to specifically disclose the limitations listed above, the same material and process are utilized in Soininen as in Applicant's invention therefore it would have the same characteristics.

Response to Arguments

6. Applicant's arguments filed 7/16/04 have been fully considered but they are not persuasive. Applicant argues that "Soininen does not teach or suggest first and second capacitor electrodes at least one of said first and second electrodes comprising a continuous ALD deposited rhodium film with reduced carbon content" and "a reduced carbon rhodium film formed by rhodium atomic layer deposition at a temperature of about 100°C to about 200°C." However, Soininen discloses a first electrode (36) and a second electrode (40) and at least one of said first and second electrode comprising rhodium film (For Example: See Figure 2 and Column 5 Lines 5-15). Additionally "a continuous ALD deposited rhodium film with reduced carbon content" and "a reduced carbon rhodium film formed by rhodium atomic layer deposition at a temperature of about 100°C to about 200°C are product by process limitations. The

limitations are not a “resulting structure having distinct and defined characteristics.” The Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. See *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with **evidence establishing an unobvious difference between the claimed product and the prior art product**. See *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). Arguments are not evidence.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica Lewis whose telephone number is 571-272-1838. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7722 for regular and after final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956

ML

September 21, 2004



AMIR ZARABIAN
SUP. PATENT EXAMINER
CENTER 2800